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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/308,403 | 10/21/1999 | COLIN STANLEY FITCHETT | BB1180B | 6086 |

26633 7590 03/04/2003

HELLER EHRLMAN WHITE & MCAULIFFE LLP
1666 K STREET,NW
SUITE 300
WASHINGTON, DC 20006

EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------|--------------------------------------|-------------------------|
| Advisory Action | Application No. | Applicant(s) |
| | 09/308,403 | FITCHETT, COLIN STANLEY |
| | Examiner Francisco C Prats | Art Unit 1651 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) _____. would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3, 7-26, 28-59.

Claim(s) withdrawn from consideration: _____.

8. The proposed drawing correction filed on _____. is a) approved or b) disapproved by the Examiner.
9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. Other: _____.

Francisco C Prats
Primary Examiner
Art Unit: 1651

DETAILED ACTION

The after-final response filed February 24, 2003, has been received and considered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

All of applicant's argument regarding the pending ground of rejection has been fully considered but is not persuasive of error. It is respectfully submitted that applicant's reading of the *Mills* case is excessively narrow. By simultaneously requiring the very limitation not met by a reference to be taught to be desirable in the utility disclosed by the reference, applicant's narrow reading of *Mills* would essentially read obviousness under § 103(a) out of existence. This is clearly not the state of the law. Applicant is reminded that motivation can be derived from recognition in the art that the claimed elements are suitable for the purpose for which they are being used. See MPEP § 2144.07 (entitled "Art Recognized Suitability for an Intended Purpose") and the cases cited therein. Because, as pointed out in previous office actions, applicant's claims are directed to the generation of peroxide by a combination of elements well recognized in the art as being suitable for that purpose, applicant's claims must be considered obvious.

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As discussed in the previous office action, the fact that Crawford teaches depolymerization as opposed to Greenshields' polymerization does not teach away from the claimed invention. As discussed in the previous office action, it must be kept in mind that while the peroxidases of the Crawford and Greenshields patents have the common feature of using peroxide as a substrate, the enzymes in these two references are clearly different to the extent that Greenshields' enzyme catalyzes a polymerization reaction and Crawford's enzyme catalyzes a degradative reaction. Thus, contrary to applicant's argument, the artisan of ordinary skill would have reasonably expected peroxide generated *in situ* to have allowed Greenshields' peroxidase to function in its normal disclosed manner.

The argument, also alleged by the Greenshields' Declaration, that the artisan of ordinary skill would have believed that hydrogen peroxide generated *in situ* would result in depolymerization in the application of the Greenshields reference, simply lacks scientific support. The process disclosed in the Greenshields reference uses hydrogen peroxide. If hydrogen peroxide would have resulted in depolymerization, then Greenshields could not have polymerized his gels. Moreover, applicant is again reminded that the rejection of record does not purport to substitute the polymerizing

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peroxidase enzyme system of Greenshields for the depolymerizing peroxidase system of Crawford. Rather, the rejection holds the claims obvious because applicant has applied a notoriously well-known method of peroxide production to a process known to require peroxide.

While applicant urges an unexpected result with respect to the amounts of glucose and glucose oxidase, it is respectfully pointed out that applicant's claims do not contain any limitations with respect to glucose or glucose oxidase amounts. Thus, applicant is arguing about a limitation not present in the claims. Moreover because there is no limitation with respect to these amounts, applicant's claims are simply not commensurate in scope with any alleged showing of unexpected result.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 703-308-3665. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can

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be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Francisco C Prats
Primary Examiner
Art Unit 1651

FCP
March 3, 2003